

28 DEC 2007



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
www.uspto.gov

David M. McConoughey  
Stoll, Miskin & Badie  
350 Fifth Ave. Ste. 4710  
New York NY 10118-4710

In re Application of  
EDUARDO DIAZ DEL RIO PEREZ  
Application No.: 10/553,663  
PCT No.: PCT/IB04/01539  
Int. Filing Date: 16 April 2004  
Priority Date: 18 April 2003  
Attorney's Docket No.: 576391-2003  
For: EXPLOSION-INHIBITING ARTICLES OF  
MANUFACTURE

DECISION ON  
PETITION  
UNDER 37 CFR 1.47(b)

This is a decision on petition under 37 CFR 1.47(b), filed 30 October 2007 to permit petitioner (applicant) to file the above-captioned application on behalf of the non-signing sole inventor, EDUARDO DIAZ DEL RIO PEREZ. Applicant's request for a four month extension of time is granted.

**BACKGROUND**

On 16 April 2004, applicant filed international application No. PCT/IB04/01539 which claimed a priority date of 18 April 2003, and which designated the United States. A copy of the international application was communicated to the United States by the International Bureau on 28 October 2004.

On 17 October 2005, within 30 months from the priority date, applicant filed a transmittal letter for entry into the national stage in the United States which was accompanied by, *inter alia*, basic national filing fee.

On 09 June 2006, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS indicating that the oath or declaration of the inventor, in compliance with 37 CFR 1.497(a) and (b) must be furnished within two months from the mail date of the notice or the application would be abandoned. Extensions of time were available.

On 09 November 2006, petitioner filed a petition requesting that the above-identified application be accepted under the provisions of 37 CFR 1.47(b). The petition was accompanied by a Statement of David M. McConoughey, regarding inventor Eduardo Diaz Del Rio Perez's refusal to sign the application, a declaration executed by the nonsigning inventor directed to the prior filed provisional application, and a copy of an Agreement executed by inventor Eduardo Diaz Del Rio Perez.

On 30 April 2007, a decision dismissing the petition was mailed indicating that applicant had not demonstrated with factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort; had not submitted an oath or declaration by the 37 CFR

1.47(b) applicant on behalf of and as agent for the non-signing inventor; and had not submitted proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application.

### **DISCUSSION**

A petition under 37 CFR 1.47(b) must be accompanied by (1) the requisite petition fee, (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage.

Petitioner previously satisfied Item (1), (3) and (6) .

With regard to Item (2), petitioner has provided adequate proof that the sole inventor refuses to sign the application. Specifically, counsel for assignee David McConoughey enumerates several attempts to contact the nonsigning inventor for his signature on the application through his attorney, without success. In a 29 September 2006 letter, Mr. McConoughey requested the nonsigning inventor Diaz Del Rio Perez to execute the declaration for this application. The inventor never responded to this letter. Thereafter, on 6 November 2006, 31 August 2007, 03 October 2007 and 11 October 2007, Mr. McConoughey communicated with the nonsigning inventor's lawyer, Daniel J. O'Connor in an attempt to obtain the nonsigning inventor's signature on the application papers. These attempts were unsuccessful. This is sufficient evidence to show that the inventor is unwilling to sign the application papers. Applicant has now satisfied Item (2).

As for Item (4), Petitioner provided a declaration executed by the inventor directed to the international application. The declaration is executed on behalf of the nonsigning inventor and identifies the 37 CFR 1.47(b) applicant. The declaration fulfills the requirement of 37 CFR 1.497(b) and complies with 37 CFR §§1.497(a) and (b) and 1.47(b). Item (4) is now satisfied.

Regarding item (5), the 37 CFR 1.47(b) applicant has proven that the invention has been assigned to the applicant. The assignment, attached to the petition, is between Eduardo Diaz Del Rio Perez and Fusaco IP Sarl. Counsel has demonstrated how this agreement is directed to the above referenced application. However, a statement under 37 CFR 3.73(b) by the assignee must also be submitted and is still outstanding. Where the oath or declaration is being signed on behalf of an assignee, see MPEP § 324. Item (5) is not satisfied.

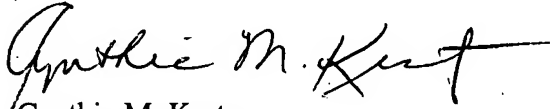
Accordingly, item (5) above is not satisfied and the petition under 37 CFR 1.47(b) must be dismissed.

### **CONCLUSION**

The petition under 37 CFR 1.47(b) is **DISMISSED WITHOUT PREJUDICE**.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



Cynthia M. Kratz  
Attorney Advisor  
PCT Legal Office  
Office of PCT Legal Administration

Tel: 571-272-3286  
Fax: 571-273-0459